

REMARKS

In the Office Action, claims 10 and 28 were objected to because of certain informalities. Claims 1-9, 11, 13-24, 26-27 and 29-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto et al., U.S. Patent No. 4,672,346 (Miyamoto et al.) in view of Sellers U.S. Patent No. 5,431,165. Claims 12 and 25 were objected to as being dependent upon a rejected base claim but deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this response, claim 10 has been amended and a erroneously duplicating the number claim 28 has been cancelled. No new matter has been added.

Upon entry of the amendments, claims 1-45 will remain pending in this application. Reconsideration and allowance of all pending claims in light of the amendments and the following remarks are requested.

Claim objections due to informalities

In the Office Action, claims 10 and 28 were objected to due to certain informalities. Claim 10 has been amended to obviate the objections raised in the Office Action. Thus reconsideration and allowance of amended claim 10 is requested. The claim erroneously marked as 28 has been cancelled. The amendments are believed to obviate the objections.

Rejections under 35 U.S.C. § 103

Claims 1-9, 11, 13-24, 26-27 and 29-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto et al. in view of Sellers. For a *prima facie* case of obviousness, the Examiner must set forth the differences in the claim over the applied reference, set forth the proposed modification of the reference, which would be necessary to arrive at the claimed subject matter, and explain why the proposed modification would be obvious.

The Office Action makes an assumption that it would have been obvious for one skilled in the art to use the Sellers's reference with the teachings disclosed by Miyamoto et al. (Point 4 on Page 3 of Office Action). The Office Action specifically points out that the Seller's teaching of using a permanent magnet to alter the magnetic field in an MRI system can be used to modify the Miyamoto's arrangement to alter the magnetic field.

However, Applicants respectfully submit that, even if, *arguendo*, the modification were possible, a person skilled in the art would have no motivation whatsoever to modify a Miyamoto et al. structure by using magnetic shims taught by Sellers. Certainly neither reference provides such teachings or motivation.

The Examiner, in formulating the rejection, indicated that Miyamoto et al. describe permanent magnets fixed to a support or yoke, with movable plugs 19. The Examiner, however, acknowledged that the plugs 19 are not, according to Miyamoto et al., permanent magnets. To accommodate this deficiency in the reference teachings, the Examiner indicated that the use of permanent magnets for shimming magnetic fields is well-known in the art, and cited Sellers for such teachings. Accordingly to the Examiner, Sellers teaches the use of permanent magnet material for shimming purposes.

However, neither reference nor the general knowledge in the art itself, would supply any motivation whatsoever for modifying either reference to result in a structure or method of the type claimed. Applicants respectfully submit that one skilled in the art, upon reading Miyamoto et al., would conclude that the "rod-like soft magnetic material" would be completely sufficient for the intended purpose. That is, nothing in the Miyamoto et al. reference, or in the Sellers reference, suggests that the rods should be or even could be replaced by permanent magnets. In essence, the Examiner has relied upon the pending claims *only* for the implication that the movable elements of the claims should be made of a permanent magnet material. Certainly, nothing in the art would suggest such modification or structures or methods.

Given the complete lack of any motivation or suggestion in the art for the modification proposed by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, the present invention, as claimed in independent claims 1, 14, 26 and 31 is patentable. Claims 2-13, 15-25, 27-30 and 32-45 depend directly or indirectly from claims 1, 14, 26 and 31, respectively, and are allowable by virtue of such dependency, as well as for the subject matter they separately recite. Thus, it is respectfully requested that the rejection of the claims under 35 U.S.C. §103(a) be withdrawn.

Claims 12 and 25 were objected to as being dependent upon a rejected base claim. As discussed above, claims 1 and 14 are patentable. Claims 12 and 25 depend directly or indirectly from claims 1 and 14 respectively, and are allowable by virtue of such dependency, as well as for the subject matter they separately recite. Thus reconsideration and allowance of claims 12 and 25 is requested.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: 6/11/2004

39
Patrick S. Yoder
Reg. No. 37,479
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545